

REMARKS

In view of both the amendments presented above and the following discussion, the Applicants submit that none of the claims now pending in the application is anticipated under the provisions of 35 USC § 102 or obvious under the provisions of 35 USC § 103. Thus, the Applicants believe that all of these claims are now in allowable form.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, the Examiner should telephone Mr. Peter L. Michaelson, Esq. at (732) 542-7800 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Status of claims

Claim 15 has been amended to correct an obvious typographical error objected to and pointed out by the Examiner. Accordingly, the Examiner is respectfully requested to withdraw the objection to claim 15.

No additional claims have been canceled or added.

Rejections

A. Rejection under 35 USC § 103(a)

The Examiner has rejected claims 14, 15 and 18, under the provisions of 35 USC § 103(a) as being unpatentable over the Spaur et al patent (United States patent 6,122,514 issued to C. W. Spaur et al on September 19, 2000) in view of the Corneliusen patent (U.S. Patent 6,819,672 issued to K. Corneliusen on November 16, 2004). With respect to claims 14, 15 and 18, this rejection is respectfully traversed.

The Examiner is respectfully requested to withdraw the § 103(a) rejection, because the Corneliusen patent is not prior art with respect to the present application. The earliest effective filing date of Corneliusen as a prior art reference under 102(e) is May 3, 1999, i.e., its earliest filing date in the U.S. According to MPEP § 901.03, "Under amended 35 U.S.C. 102(e)(1), a U.S. patent application publication under 35 U.S.C. 122(b) is considered to be prior art as of **the earliest effective U.S. filing date of the published application**. [emphasis added]. In other words, Corneliusen's foreign application priority date of May 4, 1998 is not its earliest effective filing date in the U.S.

The present application has earlier effective filing dates in the U.S., i.e., its June 8, 1998 foreign priority date based upon the filing of application

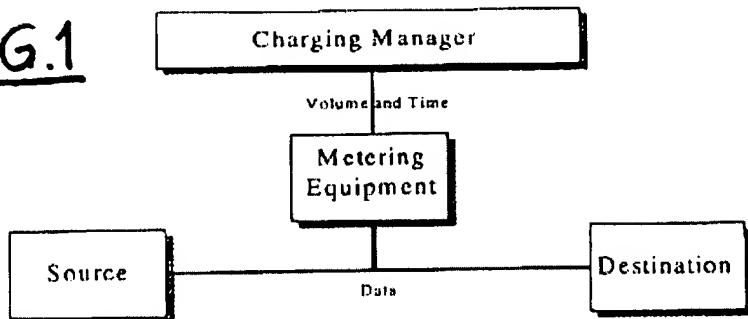
NL 1009342 in the Netherlands and its September 2, 1998 foreign priority date based upon the filing of application NL 1009987 in the Netherlands. Certified translations of the priority documents are already of record in the Image File Wrapper. Accordingly, Corneliusen is not prior art with respect to the present application, and the § 103(a) rejection based upon Corneliusen must be withdrawn.

B. Corneliusen Does Not Disclose The Claimed Measuring Device or Billing System

Assuming for the purposes of argument only, that Corneliusen might be citable prior art, Corneliusen fails to disclose the claimed measuring device or billing system of independent claim 14. The Office Action on page 3, alleges that FIG. 1 and column 1, lines 43-46 disclose these features of claim 14. The Applicants respectfully disagree.

The Charging Manager and Metering Equipment of Corneliusen's FIG. 1 are not the Applicants claimed measuring device or billing system of claim 14. For the convenience of the Examiner, FIG. 1 is reproduced below;

FIG.1



Also for the convenience of the Examiner, the cited passage of column 1, lines 43-46 of Corneliusen, which allegedly discloses the claimed features, is reproduced below:

FIG. 1 shows the metering equipment placed between the source and the destination. The calculated volume and time are collected by the charging manager, and the total charge is calculated.

It is respectfully submitted that Corneliusen fails to disclose the features of claim 14 including a measuring device for measuring a time period during which a predefined number (N) of packets that belong to a common packet connection are received or transmitted during an entire session and through the connection in order to define a measured time period (t). Corneliusen also fails to disclose that the predefined number is less than a total number of packets carried over the connection during the entire session. Lastly, Corneliusen fails to disclose a billing system for formulating a charge for use of the connection in response to the measured time period (t).

C. Independent Claim 14 is Patentable over the Combination of Spaur et al in view of Corneliusen

Applicants hereby incorporate by reference all of the arguments made in the Amendment dated March 23, 2007 as to why the Spaur et al and Corneliusen patents cannot be combined as alleged in the most recent Office Action. In addition, Applicants respectfully submit the following additional arguments.

Claim 14 has been rejected under 35 USC § 103(a) as being unpatentable over Spaur et al in view of Corneliusen. In order to establish a *prima facie* case of obviousness, a rejection made under 35 USC § 103 must meet three basic criteria. First, there must be some suggestion or reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the *claim limitations*. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants respectfully submit that Spaur et al and Corneliusen fail to teach all the claim limitations of claim 14 for the reasons stated above and in the March 23, 2007 Amendment. Accordingly,

for this reason alone the rejection under 35 USC § 103 must be withdrawn.

In addition to the cited prior art failing to teach all of the claim limitations, it is respectfully submitted that the Office Action utilizes hindsight to reconstruct the Applicants claimed combination from the teachings of Applicants own specification. Stated another way, the only reason to combine Spaur et al and Conrneliussen in the ways suggested in the Office Action is gleaned from the hindsight provide by Applicants specification which teaches the desirability of the claimed combination of features. Applicants believe that the Office Action is based upon a selective combination of features allegedly found in Spaur et al and Corneliusen, and that such selective combining is impermissible. As stated in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985), "When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." As further stated in *In re Dembicza*k, 175 F.3d 994, 999 (Fed. Cir. 1999), "A mere recitation of the elements of an invention, combined by using the inventor's own disclosure as a roadmap, cannot make such an invention obvious."

Accordingly, Applicants respectfully submit that claim 14 is also patentable over the cited prior art, because without the Applicants own disclosure, there is no

reason to combine the cited references as described in the Office Action.

D. Rejections of Dependent Claims 15-27 under 35 USC § 103

The Examiner has rejected dependent claims 15-27 under the provisions of 35 USC § 103 based at least in part upon the Corneliusen patent. Applicants respectfully submit that claims 15-27 are patentable for at least the same reasons as independent claim 14 upon which they either directly or indirectly depend, as well as, the additional features recited in each of the dependent claims.

Conclusion

Thus, the Applicants submit that none of the claims, presently in the application, is anticipated under the provisions of 35 USC § 102 or obvious under the provisions of 35 USC § 103.

Consequently, the Applicants believe that all these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

Appl. No. 09/674,347

Amdt. dated September 21, 2007

Reply to Office Action of June 26, 2007

Respectfully submitted,

September 21, 2007


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CERTIFICATE OF MAILING under 37 C.F.R. 1.8(a)

I hereby certify that this correspondence is being deposited on **September 24, 2007** with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Signature 30,090

Reg. No.